REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1-6, 8, 13-15 are currently being amended and claims 18-44 are being added. This amendment adds and changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. After amending the claims as set forth above, claims 1-44 are now pending in this application.

Claim For Foreign Priority

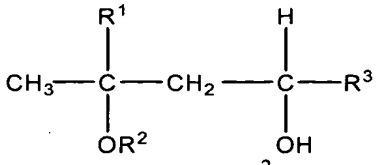
Applicant filed a certified copy of the foreign priority document on February 4, 2002, but this has not yet been acknowledged by the Examiner. Applicant requests that the Examiner acknowledge the claim for foreign priority and receipt of the certified priority document in the next communication.

IDS

Applicant filed an IDS on January 18, 2002 but have not received a copy of the attached Form 1449 initialed by the Examiner. MPEP § 609 III C(2) states that examiners are to place their initials adjacent to the citations of a PTO-1449 or PTO/SB/08 that has been considered. Accordingly, applicant requests with the next communication from the Office the return of the initialed PTO-1449 of the IDS filed on January 18, 2002.

Rejections Under 35 U.S.C. § 102

Claims 1, 3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yano (U.S. Patent No. 5,702,512). Applicant requests withdrawal of this rejection for the following reasons. Yano does not teach a ballpoint pen oil-based ink composition comprising an oil-based solvent, said oil-based solvent comprising one or more compounds having the following formula:



where R^1 and R^3 each is independently H or CH_3, R^2 is CH_3 and a polyvinyl butyral resin.

The present invention is directed to a ballpoint pen oil-based ink composition comprising the above specific solvent by which quick drying with other proper properties can be attained. The inventor improved the above ballpoint pen oil-based ink composition in preventing an ink agglomerate that solidifies in the periphery of ball, by which the problem of an extremely large load necessary in the writing by moving the ball associated with the ink agglomerate solidifies is solved.

Although some solvents mentioned in Yano have a relatively high vapor pressure, the composition of Yano does not provide the excellent properties as of the ballpoint pen of the present invention. For example, a solvent having a high vapor pressure, which is not a solvent having the formula of claim 1, is inferior in compatibility with a dye and stability or in dispersion stability with a pigment to the solvent having the formula of claim 1. The solvent of claim is not taught by Yano.

The ballpoint pen oil-based ink composition of the present invention further contains a polyvinylbutyral resin, to attain a viscosity adjustment when a dye is used and dispersion of a pigment when a pigment is used. The polyvinylbutyral resin is excellent in attaining these purposes in the ballpoint pen oil-based ink composition of the present invention containing the above specific solvent.

Further, since Yano et al. does not mention a follower at all, applicant believes that although some solvents having a relatively high vapor pressure are mentioned in Yano et al., it is not expected that such high pressure solvents are contained in an amount of the present invention. Without a follower, the solvent having a relatively high vapor pressure is evaporated and lost and a ballpoint pen cannot be used.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being obvious over Kito (U.S. Patent 5,785,746). Kito et al. is directed to a ballpoint shear thinning ink composition, i.e., a thixotropic ink composition in which a phosphoric ester and a weakly cationic component are contained to provide the ink composition with a shear thinning or thixotropic property.

The present invention basically relates to a ballpoint ink composition which comprises a specific high vapor pressure solvent having a formula as shown in claim 1 so as to provide quick drying and other properties with an aqueous ink; relates to a problem associated with a ballpoint pen using such an ink, that is, ink agglomerate solidifies in the periphery of ball; and solves the problem by comprising the specific components as stated in claim 1 to reduce an extremely large load. However, Kito et al. does disclose a phosphoric ester and a weakly cationic component, but does not disclose a combination these components with a specific high vapor pressure solvent having a formula as shown in claim 1 of the present invention and the effect obtained by the combination of the components. Further, Kito et al. does not suggest such a combination of the components even considering Yano.

Claims 1 and 9-14 are rejected under 35 U.S.C. § 103(a) as being obvious over Ichikawa (U.S. Publication No. 2003/00775074) and claims 15-17 are rejected under 35 U.S.C. § 103(a) as being obvious over Ichikawa (U.S. Publication No. 2003/00775074) in further view of Asami.

U.S. Publication No. 2003/00775074 is a patent application owned by the present assignee and therefore is not prior art under the safe harbor provision of 35 USC § 103(c). Section 103(c) is reproduced below.

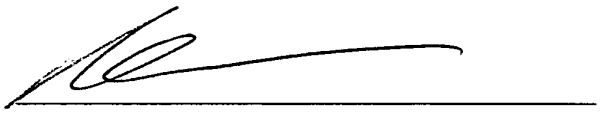
> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added).

MPEP §§ 706(l)(1)-(3) discuss in detail how examiners are to handle the safe harbor provision of this section.

Therefore, in accordance with 35 USC 103(c) and MPEP §§ 706(l)(1)-(3), the undersigned attorney of record states that, the present application and U.S. Publication No. 2003/00775074 were, at the time the invention of the present application was made, owned by Mitsubishi Pencil Co., Ltd. In accordance with MPEP § 706.02(l)(2), this statement is sufficient to disqualify U.S. Publication No. 2003/00775074 from being used as prior art in a rejection for obviousness against the present claims.

In conclusion, applicant requests withdrawal of all outstanding rejections. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,



Date December 3, 2003

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.